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OFFICE OF PETITIONS

In re Patent No. 7,109,473 :
Grier et al. :
Issue Date: September 19, 2006: DECISION ON
Application No. 10/659,153 : REQUEST FOR RECONSIDERATION
Filed: September 10, 2003 : OF
Atty Docket No. 040563-0167 : PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)," filed November 20, 2006. Patentees request that a patent term adjustment of two hundred twenty (220) days be issued in favor of applicants.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **DISMISSED**.

Patentees are given TWO (2) MONTHS from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On September 19, 2006, the above-identified application matured into U.S. Patent No. 7,109,473. The instant request for reconsideration filed Monday, November 20, 2006, was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 127 days. The PTA of 220 days was reduced by 93 days pursuant to 37 CFR § 1.704(c)(10) for the submission of a request for refund after the mailing of the notice of allowance.

Patentees agree with the calculation of 220 days of patent term adjustment at the time of the mailing of the notice of allowance. Patentees do not directly speak to the reduction of 93 days associated with the filing of a request for refund. Nonetheless, in effect, patentees dispute this reduction.

The reduction has been considered and found to be proper. It is undisputed that a request for refund was filed after the mailing of the Notice of Allowance. This is properly a basis for reduction of patent term adjustment pursuant to § 1.704(c)(10).

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

As stated in MPEP 2732:

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process.

Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following

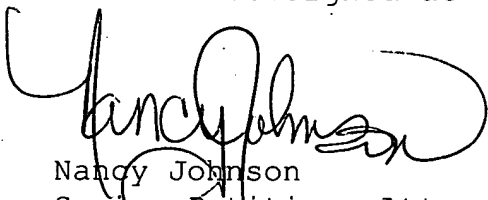
papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office). Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations.

A request for a refund is clearly stated as a failure to engage. It is undisputed that such a request was filed. In the future, patentees may want to consider filing a request for refund of the type filed, which is timely filed if filed within 2 years, after the issuance of the patent.

In view thereof, it is concluded that the patent properly issued with a revised Patent Term Adjustment of one hundred twenty-seven (127) days.

Receipt is acknowledged of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



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